



08/359945

PATENT

Attorney Docket No.: A-57518-2/DJB/JPB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) Examiner: DADIO, S.  
WEISS et al. ) Group Art Unit: 1808  
Serial No.: UNKNOWN )  
Filed: HERewith )  
For: BIOLOGICAL FACTORS )  
AND NEURAL STEM CELLS )

"Express Mail" mailing label number TB790082876US date of deposit  
December 20, 1994. I hereby certify that this correspondence, including listed  
enclosures, is being deposited with the United States Postal Service "Express Mail  
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DC 20231.

TYPED NAME Vicki L. Henry

SIGNED

Vicki L. Henry 20 Dec. 94PRELIMINARY AMENDMENT

Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

This is in response to the Advisory Action mailed 16 November 1994 (Paper  
No. 16) in connection with parent of the above-captioned application.

The Commissioner is authorized to charge any fees which may be required, or  
credit any overpayment to Deposit Account No. 06-1300 (Our Order No.  
A-57518-2/DJB).

The Examiner maintains that R1 (Reynolds and Weiss, *Rest. Neuro. &  
Neurosci.*) and R2 (Reynolds, Tetzlaff, & Weiss, *Soc. Neurosci. Abst.*), are appropriate  
references. With regards to R2, the Examiner questions why Tetzlaff is included as an  
author but is not listed as an inventor of the present application (page 2 of the  
Advisory Action). Enclosed are declarations of Drs. Weiss and Reynolds that explain  
the events that led to the inclusion of Dr. Tetzlaff as an author of the cited abstract,

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but not an inventor of the present application or related applications [see M.P.E.P. §715.01(c)]. Thus, Dr. Tetzlaff is not an inventor of the claimed subject matter and rejections under § 102(f) and/or § 103 based on R2 are not appropriate.

With regards to R1, the Examiner states that "Applicants do not obtain benefit to the filing date of 07/726,812 with respect to the new matter which was added in order to create the CIP." Thus, the Examiner deems the R1 reference appropriate because "it was published prior to the filing date of 07/961,813." It is believed that the Examiner intended to reference U.S. Ser. No. 07/967,622, of which the present application is a continuation, not 07/961,813 (a related application). In any event, the Examiner cites R1 as teaching "isolating neural stem cells from a donor tissue and proliferating the stem cells by culturing the cells in a medium comprising EGF." However, this is disclosed in U.S.S.N. 07/726,812, from which the present application claims priority, and which was filed prior to the publication of R2. Accordingly, the Examiner can not combine this teaching with the teachings of Masters *et al.* (as was done on p. 3 of Paper No. 13) in order to support an obviousness rejection. Applicants also point out that R2 was published in July 1992, less than one year prior to the filing date of 07/967,622.

Respectfully submitted,

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